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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,405	12/12/2003	Taisuke Uehara	118066	9104

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EXAMINER

BEN, LOHA

ART UNIT PAPER NUMBER

2873

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

<b>Office Action Summary</b>	Application No. 10/733,405	Applicant(s) UEHARA, TAISUKE	
	Examiner LOHA BEN	Art Unit 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 and 7 is/are allowed.
- 6) ☒ Claim(s) 4-6 and 8-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Loha Ben**  
**Primary Examiner**

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>0604</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Minor informalities noted**

#### **In the Claims**

In claim 2: line 6, "section" should be – sections --, and "hole" should be – holes - -, since the retaining frame has two holes; and line 8, "modulation" should be – modulator –(please refer to line 11).

In claim 8: line 21, "the" should be – a --, otherwise "the light modulator" has no antecedent basis; line 25, "light modulation" should be replaced with – optical modulation device – to be consistent with lines 11 and 12; and line 27, "device" should be – unit --.

In claim 9: line 5, "section" should be – sections --; line 7, "the"(second occurrence) should be replaced with – each --; and line 8, "the"(first occurrence) should be replaced with – each --.

In claim 16: line 4, "is" should be – being --.

In claims 17 and 18: line 4, "device" should be replaced with – unit --.

In claim 20: line 2, "piece" should be – pieces --.

In claim 21: line 10, "retains" should be – retain – (please note line 8 of claim 8); and line 22, "the" should be – a --.

In claim 22: line 4, "section" should be – sections --; and line 7, "the"(both occurrences), should be replaced with – each --.

In claim 24: line 3, "each" should be deleted.

In claim 29: line 5, "are" should be – being --.

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In claim 33: line 3, "piece" should be -- pieces --.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-6 and 8-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4: line 2, "the inner" has no antecedent basis.

In claim 5: line 3, "the standing piece" has no clear antecedent basis. Which one?

In claim 6: line 2, "the standing piece" has no antecedent basis.

In claim 8: line 11, "the optical modulation device retainer" has no antecedent basis. Perhaps, on line 11, "the" was meant to be -- each --. Further, the recitation on lines 22 and 23 appears to be inconsistent with that on line 9 in that the former suggests that there is a **plurality of "optical conversion elements"** in the optical device claimed, since the device comprises a **plurality of optical modulation device retainers**, whereas the latter suggests that there is **at least one ( one or more ) optical conversion element**. The phrase "at least one" suggests that in one embodiment or situation, only one optical conversion element is needed in the device, but in another, more than one is needed. In contrast to this, lines 22 and 23 always require the device to have more than one optical conversion element.

In claim 12: line 4, "the standing piece" has no definite antecedent basis. Which one?

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In claims 13 and 17: line 2, "the standing piece" has no antecedent basis.

The situation in claim 21 is similar to that noted in claim 8 above. For line 13 of the claim, please note line 11 of claim 8. For lines 11, and 23 and 24 of the claim, please refer to lines 9, and 22 and 23 of claim 8.

In claim 24: line 5, "the inner surfaces" has no antecedent basis.

In claim 25: line 4, "the standing piece" has no antecedent basis.

In claim 26: line 2, "the standing piece" has no antecedent basis.

In claim 30: lines 3 and 4, "the standing piece" has no definite antecedent basis.

The remaining claims, depending from rejected base claims, inherit the indefiniteness thereof.

#### **Allowable Subject Matter**

Claims 1-3 and 7 are allowed.

Claims 8 and 21 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claims 4-6, 9-20 and 22-33 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The prior art of record fails to teach or fairly suggest the detailed elemental combination making up the device now claimed in especially independent claim 1 ( broadest independent claim as compared with claims 8 and 21 ).

#### **Communication**

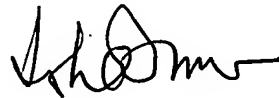
Art Unit: \*\*\*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Loha Ben whose telephone number is (571) 272-2323. The examiner can normally be reached on Monday to Saturday, generally between 12:00 noon and 8:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps, can be reached on Monday to Friday, at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 5, 2005



**Loha Ben**  
**Primary Examiner**